

### **REMARKS**

This is in full and timely response to the Final Office Action mailed on May 3, 2005. Reexamination in light of the following remarks is respectfully requested.

Claims 3, 4, 7, 8, 10, 12-14 16 and 18 are pending in this application, with claims 3, 7, and 16 being independent.

#### **I. Objections to Specification**

The specification is objected to because of informalities. The Applicants have amended the specification in order to overcome the objections. The Applicants believe that no new matter has been added.

#### **II. Request for Reconsideration of the Finality of the Office Action**

The Office Action indicates that the objections and rejections have been withdrawn, and new ground of rejection is being made of the newly discovered prior art, Alfenaar et al. (U.S. Patent No. 4,127,648). The Applicants requests review of the prematureness of the final rejection within the Final Office Action for the reasons set forth hereinbelow.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See 706.07(a).

First, the new ground of rejection is based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) since Alfenaar et al., has not been submitted by the Applicants.

Further, in this case, the final rejections are not necessitated by the Applicants' amendment of the claims nor based on information submitted in an information disclosure statement.

That is, claims 3, 4, 7, 8, 10, and 12-14 have been amended by the previous amendment, in order to cancel some of the originally listed constituents but and any elements have not been added to the amended claims. Thus, those amendments do not necessitate new ground of the rejection, since these limitations of the amended claims have been presented in the respective original claims, and any claim element has not been added by the amendments.

Further, claim 16 has also been amended by the previous amendments, in order to recite "anode cell" in the preamble, and claim 18 depending upon the amended claim 16 has been added by the previous amendments, in order to recite "a fuel cell" in the claim. However, those amendments do not necessitate new ground of the rejection since the Office Action focuses on the constituents listed in claim 16.

Thus, the new ground of rejection is neither necessitated by applicants' amendment of these claims nor based on information submitted in an information disclosure statement. Accordingly, the Applicants respectfully requests reconsideration of the finality of the Office action.

### **III. Claim Rejections under 35 U.S.C. § 102**

Claims 3, 4, 7, 8, 10, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Alfenaar et al. (U.S. Patent No. 4,127,648). This rejection is respectfully traversed at least for the following reasons.

**Claims 3, 4, 10, 13, and 14**

Claim 3 is directed to an anode catalyst for a fuel cell comprising: gold fine particles, and at least one member selected from the group consisting of gallium, indium and the oxides of these metals.

Alfnaar et al. arguably discloses a process for preparing a metal electrode. However, Alfnaar et al. does not disclose, teach or suggest the combination of “gold fine particles” and “at least one member selected from the group consisting of gallium, indium and the oxides of these metals.” Specifically, it does not disclose, teach or suggest mixtures of “metals.” That is, it discloses only mixtures of “alloying elements” but not mixture of “metals” as recited in claim 3. Thus, the applied art does not disclose, teach or suggest the features of claim 3. Accordingly, withdrawal of this rejection and allowance of the claim is respectfully requested.

Since claims 4, 10, 13, and 14 depend on independent claim 3, they are allowable for at least same reasons that claim 3 is allowable. Withdrawal of the rejection and allowance of these claims is respectfully requested.

**Claims 7, 8, 12, 13 and 14**

Claim 7 is directed to an anode catalyst for a fuel cell comprising: gold fine particles; at least one member selected from the group consisting of gallium, indium, and the oxides of these metals; and at least one member selected from the group consisting of platinum, ruthenium, and ruthenium oxides.

Alfnaar et al. arguably discloses a process for preparing a metal electrode. However, Alfnaar et al. does not disclose, teach or suggest the combination of “gold fine particles,” “at least one member selected from the group consisting of gallium, indium, and the oxides of these metals,” and “at least one member selected from the group consisting of platinum, ruthenium, and ruthenium oxides.” Alfnaar et al. discloses only mixtures of “alloying elements” but not mixtures of “metals” as recited in claim 7. Thus, the applied art does not disclose, teach or

suggest the features of claim 7. Accordingly, withdrawal of this rejection and allowance of the claim is respectfully requested.

Since claims 7, 8, 12, 13, and 14 depend on independent claim 7, they are allowable for at least same reasons that claim 7 is allowable. Withdrawal of the rejection and allowance of these claims is respectfully requested.

#### **IV. Claim Rejections under 35 U.S.C. § 103**

Claims 16 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alfenaar et al. This rejection is respectfully traversed at least for the following reasons.

Claim 16 is directed to an anode for a fuel cell comprising: a first layer whose catalyst component is one of: (1) gold fine particles, (2) gold fine particles and at least one member selected from a first group consisting of titanium, vanadium, gallium, zirconium, niobium, cerium, tantalum, indium, and the oxides of these metals, (3) gold fine particles and at least one member selected from a second group consisting of platinum, ruthenium, and ruthenium oxides, and (4) gold fine particles, at least one member selected from the first group and at least one member selected from the second group, wherein the first layer is formed on a platinum catalyst layer.

Alfenaar et al. arguably discloses a process for preparing a metal electrode. However, Alfenaar et al. does not disclose, teach or suggest that the first layer is formed on a platinum catalyst layer.

Thus, the applied art does not disclose, teach or suggest the features of claim 16. Accordingly, withdrawal of this rejection and allowance of the claim is respectfully requested.

Since claim 18 depends on independent claim 16, it is allowable for at least same reasons that claim 16 is allowable. Withdrawal of the rejection and allowance of these claims is respectfully requested.

**V. Conclusion**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. AIS-0010 from which the undersigned is authorized to draw.

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Respectfully submitted,

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